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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/629,749	07/31/00	MAPLES	D

EXAMINER	
TRAN, T	
ART UNIT	**PAPER NUMBER**
2161	3

DATE MAILED: 11/22/00

TM02/1122

DURHAM RUSSELL MAPLES
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/629,749	Durham R. Maples
Examiner	**Group Art Unit**
Tongoc Tran	2161

☒ Responsive to communication(s) filed on *Jul 31, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1 and 6-10* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1 and 6-10* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

Since the new specification has been modified to exclude the implementation of a computer to the claimed invention, Applicant is introducing new subject matter into the specification because the process of the claimed invention is no longer considered to be a computer implemented process.

Therefore, Applicant is advised to choose from the following options:

1) Resubmit the original specification filed with the parent case 09/071,878 to replace the new specification.

2) Refile the application as a Continuation-In-Part Application (CIP).

This application repeats a substantial portion of prior Application No. 09/071,878, filed on 5/4/1998, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a

continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

3) If Applicant desire to maintain the new specification, Applicant may not receive the benefit of an earlier filing date under 35 U.S.C. 120, instead, the effective filing date would be 7/31/2000.

A preliminary amendment is filed with claims 2-5 of the original application canceled and claims 1, 6-10 are presented for examination.

Information Disclosure Statement

2. The Information Disclosure Statement filed on 7/31/2000 has been reviewed and considered.

Claim Objections

3. Claim objected to because of the following informalities: .

Claims 8-10 indicate that the claims are dependent on claim 2 which is canceled. For the purpose of prosecuting the application, the Examiner assumes that Applicant intends to refer the claims to the dependent on the previous independent claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claims 1, 6-10 are rejected under 35. U.S.C. 101 because the invention is directed to non-statutory subject matter under the examination guidelines for computer related inventions. The subject matter sought to be patented must be useful process, machine, manufacture or composition of matter. The claimed invention is directed towards *a share bond for enhancing a business entity's own stock.* A share bond is not a process, machine, manufacture or composition of matter and it is not within the technological arts. Because the claimed invention does not have a practical application in the technological arts to satisfy the utility requirement, it is deemed to be non-statutory.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art ("the pair-shared REIT's, specification, page 5, paragraph 1 (hereinafter REIT's) and Bruck ("The Predactor's Ball, A penguine book, 1988).

Regarding to claim 1, REIT's discloses a method of enhancing the stock, or any divisions of ownership or equity of a business entity, comprising joining the shares of stock (see specification page 5, paragraph 1).

REIT's does not teach the joining of the shares of stock is at no cost, no loss financially to any current and/or future shareowner, whereby any principal or issue is zero, unpaid or paid by any means other than any current and/or future shareowner paying any money or property for the bonds.

However, Bruck discloses "the advantage of the same debt-favoring provision of the U.S. Tax code: interest (on bonds) is tax deductible, but dividends of the US (on stock) is not...". Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify REIT's share of joined real estate trust with share of stock to include the share of bond joining stock for the tax benefit of non-investment bond. Furthermore, Official Notice is taken that investment bond would not be considered tax deductible in the US tax law, it would have been obvious to incorporate the share of bond as a non-investment which corporation does not receive any payment in exchange for issuing of the bond in order to qualify for tax deductible status.

Regarding to claim 6, REIT's discloses a share of real estate trust issued to a share of equity of a business entity.

REIT's does not discloses the issued to the share of equity of a business entity is with a debt instrument. However, Bruck disclose debt favoring provision of the US tax code with interest on bond (or debt instrument) is tax deductible and interest on dividend on stock is not. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify REIT's joining of a share of real estate trust to joining a share of bond to a share of stock (or share of equity of a business entity) for tax benefit since REIT's is no longer qualified as tax exemption status since 1983.

Regarding to claim 7, REIT's discloses a method of enhancing the equity of a business entity, comprising a share of real estate trust issued to a share or shares of stock of said business entity (see specification, page 5, paragraph 1), REIT's does not explicitly discloses said share of business entity is joined with a debt instrument and said business entity the right to the sum certain in money to be paid on a specified date and the right to the interest from said share to said shares of equity of said business entity.

However, Bruck discloses the debt favoring provision of the US tax code that interest paid on bond is tax deductible but interest paid on dividend is not. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify REIT's joining of a share of real estate trust to joining a share of bond to a share of stock (or share of equity of a business entity) for tax benefit.

Official Notice is taken that it is old and well known that bond issuer conveys the right to the sum certain in money to be paid on a specified date and the right to the interest from said share of bond. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the promissory note to pay a sum of money and a fixed rate of interest to the REIT's pair-shared once a share of bond is joined with a share of stock.

Regarding to claim 8, REIT's discloses a method or process of claim 6. REIT's does not explicitly discloses said business entity giving a written unconditional promise to pay on a specified date a sum certain in money and to pay a fixed rate of interest, thereby forming a debt instrument, the right to said sum certain in money and the right to said fixed rate of interest from said debt instrument is issued or conveyed to a share or shares of equity of said business entity.

However, Official Notice is taken that it is old and well known that bond holder receive a written unconditional promise to pay on a specified date a sum certain in money and to pay a fixed rate of interest. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the promissory note to pay a sum of money and a fixed rate of interest to the REIT's pair-shared once a share of bond is joined with a share of stock.

Regarding to claim 9, REIT's in view of the Examiner's Official Notice discloses the method or process of claim 6, comprising said business entity giving a written unconditional promise to pay on a specified date a sum certain in money and to pay a fixed rate of interest from said debt instrument, the right to said sum certain in money and the right to said fixed rate of

interest from said debt instrument is issued or conveyed to a share or shares of equity of said business entity (as already addressed in previous claim 8), whereby said debt instrument cannot be separated from said share or shares of equity (see specification page 5, pair-shared REIT's is inherently can not be separated). REIT does not explicitly discloses said debt instrument is not owned by the shareowner and is not traded as a listed security.

However, Official Notice is taken that in order for a bond to be tax deductible, it can not be an investment bond. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the issuing of the debt instrument (or bond) to REIT's so that it can be considered as a non-investment and therefore business entity can not received payment from issuing of the bond for tax benefit.

Regarding to claim 10, the claimed invention is the similar to the limitation already addressed in claim 9. REIT's further discloses said interest rate is tax deductible (see specification, page 5, line 3).

Conclusion

12. Claims 1, 6-10 are rejected.

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-0040, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran, whose telephone number is (703) 305-8967 and whose e-mail address is Tongoc.Tran@uspto.gov. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768. The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

TT
6 July99

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100